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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/599,623	07/07/2007	John Anthony Downes	102965-010100	1812

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GREENBERG TRAURIG LLP (LA)
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INTELLECTUAL PROPERTY DEPARTMENT
SANTA MONICA, CA 90404

EXAMINER

MEYER, JACOB B

ART UNIT	PAPER NUMBER
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3618

NOTIFICATION DATE	DELIVERY MODE
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04/01/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/599,623	Applicant(s) DOWNES, JOHN ANTHONY	
	Examiner JACOB MEYER	Art Unit 3618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-10 and 12-14 is/are pending in the application.
- 4a) Of the above claim(s) 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-10,12,14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Response to Amendment

1. Acknowledgment is made of the amendment filed with the RCE dated 03/01/2010.

Claims 1-4, 6-10, and 12-14 are pending. Claim 13 is withdrawn. Claims 5 and 11 are cancelled.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-4, 6-10, 12 and 14 are rejected under 35 U.S.C. 103(a) as obvious over Downes (UK Pat. No. 2,229,689) in view of Metcalf (US Pat. No. 5,257,822).

Regarding claim 1, Downes discloses a device (Figure 1) for preventing spray from emerging from a wheel of a vehicle (Abstract), the device comprising a generally planar panel (the entire device disclosed in Figures 1-3, comprising Elements 4-10) mounted substantially vertically behind a vehicle wheel and spaced therefrom (Figure 1) for receiving on a first side (location of Element 4 in Figure 1) water released by the wheel as it rotates (page 2, paragraphs 2-4), the panel including at least one passage (Element 6) which leads from the first side to a rear second side of the panel (Figure 3), the at least one passage being other than normal to the plane of the panel (as seen from Figure 3), and at least one vertically extending water-collecting pocket (Element 7) along the side of the at least one passage, wherein, in use, air and water entering the at least one passage are separated so that air passes through the at least one passage and mixes

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with ambient air on a second side of the panel, and water collects in the at least one water-collecting pocket (see at least paragraphs 2-3 of page 2). For further detail please see the remaining figures and specification. Downes discloses a generally planar panel (see above) that extends partially around a road wheel. Downes does not specifically disclose said generally planar panel being linearly and vertically extending. Metcalf discloses a generally planar linearly and vertically extending panel (Figure 1, Element 1) in use with a spray prevention device. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated the technique of employing a generally planar linearly and vertically extending configuration as in Metcalf (and others as previously cited in the conclusion of the Office action dated 04/13/2009) with the structure as disclosed in Downes, since it was well-known in the art to provide spray guards that are generally planar, since this arrangement would provide an easily interchangeable or replaceable spray prevention device for on-road vehicles providing greater spray suppression. Therefore, the above combination is no more than the simple application of a known technique to a piece of prior art ready for improvement yielding the predictable results of an easily interchangeable or replaceable spray prevention device for on-road vehicles providing greater spray suppression. Please note that it is merely the techniques being disclosed by the prior art that are of importance to the combination, and as a result, it would have also been obvious to one having ordinary skill in the art to alternatively substitute the technique of Downes with the teachings of Metcalf. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have applied the known technique of the spray suppression technique as disclosed by the structure of Downes to a piece of prior art ready for improvement as with the generally planar

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linearly and vertically extending guard as in Metcalf, thus yielding the predictable results of an easily interchangeable or replaceable spray prevention device for on-road vehicles providing greater spray suppression.

Regarding claim 2, Downes in view of Metcalf discloses the invention wherein the panel is formed from a plurality of vertically extending baffles (at least shown at Elements 4, 5 of Figure 3 of Downes) positioned in a side by side relationship with passages therebetween (also see page 2, paragraph 4 of Downes).

Regarding claim 3, Downes in view of Metcalf discloses the invention wherein the plurality of vertically extending baffles are substantially identical in shape (Figure 3, and page 2 at least at paragraph 4 of Downes).

Regarding claim 4, Downes in view of Metcalf discloses the invention wherein the plurality of vertically extending baffles overlap one another (at least at Figure 3, and page 2 paragraph 4 of Downes).

Regarding claim 6, Downes in view of Metcalf discloses the invention wherein the at least one passage is non-linear (at least at Figure 3, and page 2 paragraph 4 of Downes).

Regarding claim 7, Downes in view of Metcalf discloses the invention wherein the water-collecting pockets are arranged so as to collect water following a change of direction in the at least one passage (at least at Figure 3, and page 2 paragraph 4 of Downes). It is noted that it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations.

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Regarding claim 8, Downes in view of Metcalf discloses the invention wherein the at least one passage has two changes of direction (at least at Figure 3, and page 2 paragraph 4 of Downes).

Regarding claim 9, Downes in view of Metcalf discloses the invention wherein the at least one pocket is a channel running substantially vertically along a respective baffle, so that, in use, water drains from the baffles onto a surface on which the wheel is traveling (at least at Figure 3, and page 2 paragraph 4 of Downes).

Regarding claim 10, Downes in view of Metcalf discloses the invention wherein the channel is substantially U-shaped (at least at Figure 3, and page 2 paragraph 4 of Downes).

Regarding claim 12, Downes in view of Metcalf discloses the invention wherein the baffles overlap one another (at least at Figure 3, and page 2 paragraph 4 of Downes).

Regarding claim 14, Downes in view of Metcalf discloses a method for preventing spray from emerging from a wheel of a vehicle, the method comprising: providing a generally linear and vertically extending planar panel for receiving on a first side water released by the wheel as it rotates, the panel including at least one vertically extending passage which leads from the first side to a rear second side of the panel, the at least one passage being other than normal to the plane of the panel, and at least one water-collecting pocket along a side of the at least one passage, wherein, in use, air and water entering the at least one passage are separated so that air passes through the at least one passage and mixes with ambient air on a second side of the panel, and water collects in the at least one water-collecting pocket; and mounting the planar panel substantially vertically behind a vehicle wheel and spaced therefrom for the reasons stating obvious with respect to claim 1 above. The apparatus as claimed is obvious over Downes in

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view of Metcalf as discussed above regarding claim 1. Furthermore, since the prior art device as disclosed with reference to the independent claim in its normal and usual operation would be utilized in the manner as claimed herein as a method for preventing spray from emerging from a wheel of a vehicle, the claimed method is considered to be obvious in view of the prior art device. It has been held that when the prior art device is the same as a device described in the specification for carrying out the claimed method, it can be assumed the device will inherently perform the claimed process. Additionally, it has been held that to be entitled to weight in method claims, the recited structure limitations therein must affect the method in a manipulative sense, and not amount to the mere claiming of a use of a particular structure.

Response to Arguments

4. Applicant's arguments filed 03/01/2010 have been fully considered but they are not persuasive. Applicant argues that Downes panel is not linearly and vertically extending. However, as noted above, it would have been obvious to have incorporated the characteristics of the panel of Downes into a linearly and vertically extending panel as was well-known in the art. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the adaptability of the product to a pre-existing vehicle) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. Moreover, it has been held that an element "adapted to" perform a function is not a positive limitation and would not constitute a positive limitation in any patentable sense. Regarding claim 13, the examiner withdrew the claim from further consideration as noted in the Election/Restrictions section in the action mailed 12/02/2009 additionally noting that the claim

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contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Amending claim 13 to depend from claim 1 does not overcome either above noted deficiency. The claim is still directed to a different and distinct species and contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Accordingly, claim 13 remains as withdrawn. Applicant recites a dictionary definition of "planar" to argue that the Downes device can in no way be considered "generally planar." It is noted that Applicant merely recited the definition of "planar" and not a definition of "generally planar" which is the limitation rejected by the examiner. A "generally planar" panel is not the same limitation as a "planar" panel. Downes in view of Metcalf discloses a generally planar panel mounted substantially vertically behind a vehicle wheel and spaced therefrom. In response to applicant's argument that the prior art combination does not teach the air flow characteristics of the instant application, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. The above rejection meets the claimed structural limitations and any allegation as to air flow characteristics is mere speculation. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning (see "without Applicant's teachings" on page 7 of the response), it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was

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made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. In response to applicant's argument that the Downes device and Metcalf device would not be combined because of their differing structure (see arguments under Conclusion in particular), the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. Accordingly, the combined teachings of the references would have suggested the generally planar linearly and vertically extending panel technique of Metcalf (which is capable of being attached in a number of locations as evidenced by the flap and side skirt embodiments) capable of being adapted to a pre-existing vehicle, and the techniques of passages, pockets, and so on as in Downes. Therefore, the above combinations are no more than the simple substitution or application of a known technique (such as the spray suppression technique as disclosed by the structure of Downes) to a piece of prior art ready for improvement (such as the generally planar linearly and vertically extending guard as in Metcalf) yielding the predictable results of an easily interchangeable or replaceable spray prevention device for on-road vehicles providing greater spray suppression. Please note again that it is merely the techniques being disclosed by the prior art that are of importance to the combination, and as a result, it would have also been obvious to one having ordinary skill in the art to alternatively substitute the technique of Metcalf with the teachings of Downes.

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Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Sheppard '347 discloses a replaceable generally planar linearly and vertically extending panel for reducing road vehicle spray. Iwanicki '694 discloses a spray prevention device having a generally planar linearly and vertically extending panel mounted behind and spaced from the vehicle wheel. Bajorek '750, Morin '276, Morin '846, Lightle '606, and Barry '751 disclose a replaceable spray prevention device having a generally planar linearly and vertically extending panel mounted behind and spaced from the vehicle wheel.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JACOB MEYER whose telephone number is (571)270-3535. The examiner can normally be reached on Monday - Thursday 9am to 7pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, PAUL N. DICKSON can be reached on 571-272-7742. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. M./

Examiner, Art Unit 3618

/Paul N. Dickson/

Supervisory Patent Examiner, Art Unit 3616